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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,481	09/14/2000	Toshio Yamagiwa	P107348-0004	2402
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ARENT FOX KINTNER PLOTKIN & KAHN 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036				
EXAMINER FISCHER, JUSTIN R				
ART UNIT PAPER NUMBER				
1733				

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

### Advisory Action

Application No.

09/623,481

Applicant(s)

YAMAGIWA, TOSHIO

Examiner

Justin R Fischer

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

#### PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C 103 rejections of claims 4, 5, and 8.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 4, 5 and 8.

Claim(s) withdrawn from consideration: 2, 6 and 7.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

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**Continuation of 5:** The rejections of claims 4, 5, and 8 under 35 U.S.C. §103 have been withdrawn in light of applicant's arguments. In particular, the aforementioned rejections are withdrawn due to the combination of (a) applicant's assertion that "it is not possible that the inventor of the present application, Toshio Yamagiwa, derived the claimed invention from Takeshi Ishikawa" and (b) the examiner's lack of factual evidence to suggest that the claimed inventive concept was derived from the Ishikawa et al. patent.

As to the double patenting rejection, applicant argues that the application and the Ishikawa et al. patent share a common assignee and as such the application and the patent do not have "no common assignee" as required by MPEP 804. The examiner disagrees. While the claimed invention and the patent have a "shared entity" (Honda Giken Kogyo Kabushiki Kaisha), they do not have a "common assignee". The term "common assignee" (analogous to "commonly owned") is intended to mean that the subject matter which would otherwise be prior art (Ishikawa et al. patent) to the claimed invention and the claimed invention are **entirely or wholly owned** by the same person(s) or organization(s) at the time the claimed invention was made. In this instance, it does not appear that the claimed invention and the patent were entirely or wholly owned by the same person(s) or organization(s) at the time of the claimed invention. To overcome this rejection, applicant must provide sufficient evidence to establish common ownership at the time the claimed invention was made. As set forth in MPEP 706.02(I), sufficient evidence can be provided in the form of a statement that identifies the application and the patent as being commonly owned at the time the claimed invention was made.

  
Justin Fischer

December 5, 2003

  
JEFF H. AMBERGUT  
PRIMARY EXAMINER  
GROUP 1300